

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Docket No.: 10004559-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Robert E. Johnson et al.

Application No.: 09/845,839

Confirmation No.: 3219

Filed: April 30, 2001

Art Unit: 2161

For: SYSTEM AND METHOD FOR VALIDATION
OF STORAGE DEVICE ADDRESSES

Examiner: F. Coby

PETITION TO VACATE FINALITY OF OFFICE ACTION
UNDER 37 C.F.R. § 1.181

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Petitioner respectfully requests to have the finality of the Final Office Action dated October 18, 2006 (hereinafter "*Office Action*") vacated as premature under 37 C.F.R. § 1.81. The finality of the *Office Action* is improper because the *Office Action* has introduced new grounds of rejection that were not necessitated by any amendments to the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. 1.97(c). See MPEP § 706.07(a).

I. Statement of Facts

In the *Office Action*, the Examiner subjected claims 1-30 to new grounds of rejection. According to the Examiner,

[t]he amendment[s] to claims 1, 21 and 29 have changed the scope[] of the previously presented claims 1, 21 and 29. Therefore, [the amendments] require[] a new ground of rejection . .

Office Action at p. 2. However, the amendments referred to by the Examiner merely deleted a few words from the preamble of claims 1, 21, and 29 in order to overcome indefiniteness rejections raised in a prior action. *See* Petitioner's Amendment (mailed July 27, 2006) at p. 7.

More specifically, the amendment to claim 1 was as follows:

1. (Currently Amended) A method ~~for validating a storage device, the method~~ comprising:
 - storing discovery information relating to a storage device;
 - querying said storage device for device identification information; and
 - comparing at least a portion of returned device identification information to at least a portion of said stored discovery information.

Claims 21 and 29 were similarly amended. Petitioner believes that these amendments were minor in nature, and did not change the scope of the claims. In fact, these amendments only deleted language originally used in the claims' preambles, part of which remained in the body of the claim—e.g., “storage device.” Accordingly, Petitioner respectfully asserts that the *Office Action* was prematurely made final.

Moreover, the new rejections were not necessitated by Petitioner's amendment, at least, because the same rejections could have been raised against these claims prior to the amendment. As a result of the premature finality of the *Office Action*, Petitioner has been improperly denied of an opportunity to respond to the new art rejections.

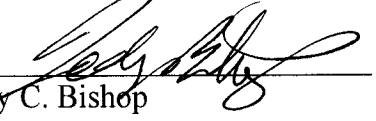
II. Conclusion

For the reasons discussed above, the finality of the present Action is improper and should be vacated. Because Petitioner believes that the facts presented herein support vacating the finality of the Action, it is believed that no fees are due in connection with this petition; however

should the Commissioner determine that any fees under 37 C.F.R. §§ 1.16 – 1.21, including any petition fees, are required for any reason, the Commissioner is hereby authorized to deduct said fees from Fulbright & Jaworski Deposit Account No. 06-2380, under Order No. 10004559-1 from which the undersigned is authorized to draw.

Dated: February 15, 2007

Respectfully submitted,

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